UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,622	06/16/2000	Geoffrey W. Simons	INFS115627	1037

			EXAMINER
20322	7590	12/08/2005	HUYNH, CONG LAC T

SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/595,622	SIMONS, GEOFFREY W.
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*21 October 2005*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,11,19,20,22,23,27,28 and 36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,11,19,20,22,23,27,28 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 10/21/05 to the

application filed on 6/16/00, priority filed 6/16/99.

2.   Claims 1-8, 11,19-20, 22-23, 27-28, 36 are pending in the case. Claims 1, 11,

19, 26, and 36 are independent claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 1-8, 11,19-20, 22-23, 27-28, 36 remain rejected under 35 U.S.C. 103(a)

as being unpatentable over Markus et al. (US Pat No. 6,490,601 B1, 12/3/02, filed

1/15/99) in view of Mohan et al. (US Pat App Pub No. 2003/0140312 A1, 7/24/03, filed

11/26/02, priority 5/14/99).

Regarding independent claim 1, Markus discloses:

- creating a user profile associated with a user, wherein said user profile includes

  user data (**figure 6, #604, #608**: retrieving user's raw data profile and merging

  user's raw data profile with mapping table inherently show that each of a plurality

  of user profiles are created and stored in memory so that the user data profiles

  including user data can be retrieved or used later)

- obtaining an electronic form having a field to be completed (**col 5, lines 1-12, 29-**

  35: "a form mapping containing a set of associations between *fields in the*

  electronic form ...", "*...enabling automatic insertion of user information into an*

  electronic form having multiple fields ...")

- dynamically generating a form map, wherein the form map identifies an

  association between the user data and the field in the electronic form (**col 5,**

  lines 1-55: "*A form mapping containing a set of association between fields in the*

  electronic form ... Each raw data file containing data strings, each data string

  corresponding to a pre-named field. Each raw data file is associated with a

  registered user ... The form mapping is utilized to attach a data string to the field

  in the electronic form where the pre-named field and the field in the electronic

  form have been previously matched or mapped ... a form mapping is utilized to

  attach a data string to the field in the electronic form ... comparing data relating

to the field in the electronic form..."; since each user has different raw data file,

generating such form map varies according to each user data file, said

generating is performed dynamically according to each user; **col 14, line 30 to**

col 16, line 28: *"... the user cookie is used to obtain the user's raw data, which*

includes actual data values and preferences associated with each data value.

The practices mentioned above associated with legacy names and the

preferences associated with user raw data values are stated in terms of

conditions ..."; mapping data into the form is performed according to the form

map where the form map (or the form mapping) varies according to various

conditions and preferences from each user inherently shows that the form map is

generated dynamically according to various conditions and preferences from

each user)

- obtaining the user profile from a fill server (**col 5, lines 29-41, 45-55**: "a *server* for

    enabling *automatic insertion of user information into an electronic form* having

    multiple fields ...*The server contains a memory area storing <u>multiple raw data</u>*

    <u>profiles</u> where each raw data profile corresponds to a registered user ...", *"the*

    raw data profile includes several standard field names, each standard field name

    having a corresponding data string and a use-preference data item determined

    by a registered user...")

- completing the field according to the form map with the user data (**figure 4B,**

    #440, [0099]: "Browser transmits *filled out electronic form document*" inherently

    shows completing a field according to the form map for a field in the electronic

form with the user data in the raw data file; **col 6, line 63 to col 7, line 23**: filling

a form with data from the privacy bank shows completing the field in the form

with the user data according to the form map)

Markus does not disclose:

- obtaining user entered data from the electronic form, wherein the user entered

    data is at least one of absent from the user profile and different from the user

    data in a corresponding field

- updating the user profile with the user entered data

Mohan discloses:

- obtaining user entered data from the electronic form, wherein the user entered

    data is at least one of absent from the user profile and different from the user

    data in a corresponding field ([0095]: user enters data not found in the user's

    profile to the form)

- updating the user profile with the user entered data ([0095], [0096], [0102]:

    storing the form submitted with user-entered information to the IIM at server

    where the user-entered data can be data not found in the user's profile implies

    that data in the user profile at IIM is updated with the user-entered data)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Mohan into Markus for automatically updating the user

profile with user-entered data which is not found in the user profile. Thus, users do not

have to remember to update the user profile every time they enter a new data not in the

user profile before.

Regarding claim 2, which is dependent on claim 1, Markus discloses that obtaining a

user profile includes:

- transmitting a user identification and a signature of the electronic form to a fill

  server (**col 8, lines 1-14**: "User 302 informs privacy bank server 308 of the

  identity of the user and of which Web site and which form on that Web site (if

  more than one) the user wishes to have filled in. *This information is transmitted*

  to privacy bank server ...")

- obtaining the user profile from the fill server, wherein the user profile corresponds

  to the user identification (**col 8, lines 40-64**: the raw data profile storage area

  328, one of the components of the privacy bank server which enables to fill in the

  electronic form on a remote user computer, includes the data profile for each

  registered user)

Regarding claim 3, which is dependent on claim 2, Markus discloses that the user

identification includes a user ID and a user password (**col 8, lines 40-64**: "a registered

user has an unique account that can be used as an identifier and a password...").

Regarding claim 4, which is dependent on claim 2, Markus discloses that the electronic

form signature includes a text string having a uniform resource locator of the electronic

form (**col 7, lines 40-62**: "a purchasing form, typically an HTML document, is returned

and downloaded into and displayed in a browser window..."; the fact that the purchasing

form is a HTML document inherently shows that the HTML document, which includes

the electronic form, has an uniform resource locator; **col 11, lines 43-49**: the user

identifier and the URL for identifying the document containing the form; **col 13, lines 38-**

48: the identifier of the electronic form contains the identifier of the merchant's Web site

in the form of a URL).

Regarding claim 5, which is dependent on claim 4, Markus discloses that the electronic

form signature includes a descriptor of the one or more fields of the electronic form (**col**

17, lines 8-15: the name strings or field names or guides to entering data in an

electronic form; **col 9, lines 1-13**: the field names are the descriptors of the fields in an

electronic form).

Regarding claim 6, which is dependent on claim 4, Markus discloses that the electronic

form signature includes a descriptor of form field requirements (**col 11, lines 39-49**: the

fact that the URL which is used by the privacy bank server *to determine how the*

electronic form document should be filled implies that said URL, which is the electronic

form signature, contains a descriptor of form field requirements).

Regarding claim 7, which is dependent on claim 1, Markus discloses that the user

profile is represented by a graphical icon on a display screen and wherein the user data

is transferred to the electronic form on manipulation of the graphical icon within the

display screen (**col 11, lines 15-22**: ".. by *clicking on the autofill button*, the user allows

the browser to execute the shippable code or *profile stored thereon..."*).

Regarding claim 8, which is dependent on claim 1, Markus discloses that the user

profile includes shippable code embodying the user data corresponding to the fields of

the electronic form, and wherein completing at least one of the fields of the electronic

form includes executing the shippable code to complete at least one of the fields of the

electronic form (col 5, lines 29-44).

Regarding claim 11, which is dependent on claim 1, Markus discloses:

- displaying a second application indicative of the user profile containing data

   corresponding to at least the field of the electronic form according to the form

   map (**figure 4A, #408-418**: the fact that the browser for displaying the electronic

   form connects with the privacy bank and gets cookie and user data

   corresponding to the cookie from the privacy bank server inherently shows that

   the user profile data of the privacy bank server is displayed in a different window

   in a second application; **col 10, lines 1-35 and col 8, lines 19-39**)

Regarding claim 19, which is dependent on claim 1, Markus discloses:

- generating a fill bundle corresponding to a merger of data within at least one of

   the user profile and the form map corresponding to a form signature, wherein the

   fill bundle is embodied in a graphical representation (**figure 6, #608** Server

   merges mapping table with user's raw data profile, **#610** Server converts merger

   into shippable code and **col 13, line 49 to col 14, line 29**: generating a

shippable code in the form of a JavaScript program where the shippable code,

converted from the merger of legacy bank name and raw data value associated

with one of a plurality of users, is used to fill in the form on the user browser; the

shippable code bundles data for filing the electronic form, and is corresponding to

a fill bundle)

Regarding claim 20, which is dependent on claim 1, Markus discloses obtaining the

user profile corresponding to a user identification from a database having one or more

user profiles organized according to the user identification (**figures 3A-B and col 8,**

lines 40-64: raw data profile contains sets of data relating to registered user of the

privacy bank service where a registered user has a unique account number as a user

identification).

Regarding claim 22, which is dependent on claim 1, Markus discloses that if the form

map database does not have a form map corresponding to the form signature,

generating a new form map based upon the form signature (**col 13, line 49 to col 14,**

line 4: the privacy bank server uses the URL or other identifier for the specific form to

be filled out to retrieve a mapping of each field name in the electronic form to privacy

bank standardized names; the merchant submits one or more forms to privacy bank

which then examines each field name in the forms and matches it with a privacy bank

field name; the fact that if the legacy name does not match the privacy bank field

names, then the privacy bank user raw data *can be updated to* include the legacy name

based upon the identifier of the form <u>indicates that</u> when the privacy bank server whose form map database does not have the form map of the newly submitted form from the merchant, the privacy bank raw data *is updated to include the newly created form map of the new form based upon the corresponding URL or the form signature*).

Regarding claim 23, which is dependent on claim 19, Markus discloses that the fill bundle includes shippable code containing commands for completing one or more corresponding fields of the electronic form (**col 14, lines 5-29**: "normally browser programs have a JavaScript component that is manipulable by JavaScript commands. *These JavaScript commands in the shippable code are used to fill in the electronic form on the browser*, a technique well known in the field of Internet and Java programming..").

Regarding claim 27, which is dependent on claim 1, Markus discloses that the system further comprises a user information server in communication with the fill server and providing user profile data to the fill server (**col 7, line 63 to col 8, line 39**: the fact that the Markus system has the capability of providing user profile data and creating fill bundle embodied in shippable code for filling data in the user profile to electronic forms in a remote computer inherently shows that the Markus system includes a user information server in communication with the fill server).

Regarding claim 28, which is dependent on claim 1, Markus discloses a form map

server in communication with the fill server and providing form maps corresponding to at

least one field of an electronic form, wherein a graphical representation includes a

merger of the form map and the user profile data (**figure 6 and col 13, line 49 to col**

14, line 29: the merger of mapping table, including form map, with user's raw data

profile in a user's browser shows that the graphical representation of the browser

window includes the merger; the mapping table retrieved from the privacy bank

database connected to the user's browser where to display the form and the web site

that contains the form and to fill in the form inherently shows that the privacy bank

database which stores the table of form mapping is considered as a form map server,

and the privacy bank server is where to create the fill bundle embodied in shippable

code is considered as the fill server).

Regarding independent claim 36, Markus discloses:

- creating a user profile associated with a user, wherein said user profile includes

  user data (**figure 6, #604, #608**: retrieving user's raw data profile and merging

  user's raw data profile with mapping table inherently show that each of a plurality

  of user profiles are created and stored in memory so that the user data profiles

  including user data can be retrieved or used later)

- obtaining an electronic form having at least a field to be completed (**col 5, lines**

  1-12, 29-35: "a form mapping containing a set of associations between *fields in*

the electronic form ...", "...enabling automatic insertion of user information into an

electronic form having multiple fields ...")

- dynamically generating a form map, wherein said the form map identifies an

association between the user data and the field in the electronic form (**col 5,**

lines 1-55: "*A form mapping containing a set of association between fields in the*

electronic form ... Each raw data file containing data strings, each data string

corresponding to a pre-named field. Each raw data file is associated with a

registered user ... The form mapping is utilized to attach a data string to the field

in the electronic form where the pre-named field and the field in the electronic

form have been previously matched or mapped ... a form mapping is utilized to

attach a data string to the field in the electronic form ... comparing data relating

to the field in the electronic form..."; since each user has different raw data file,

generating such form map varies according to each user data file, said

generating is performed dynamically according to each user; **col 14, line 30 to**

col 16, line 28: "*... the user cookie is used to obtain the user's raw data, which*

includes actual data values and preferences associated with each data value.

The practices mentioned above associated with legacy names and the

preferences associated with user raw data values are stated in terms of

conditions ..."; mapping data into the form is performed according to the form

map where the form map (or the form mapping) varies according to various

conditions and preferences from each user inherently shows that the form map is

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each user)

- obtaining the user profile from a fill server (**col 5, lines 29-41, 45-55**: "a *server* for

enabling *automatic insertion of user information into an electronic form* having

multiple fields ...*The server contains a memory area storing <u>multiple raw data</u>*

<u>profiles</u> where each raw data profile corresponds to a registered user ...", "*the*

raw data profile includes several standard field names, each standard field name

having a corresponding data string and a use-preference data item determined

by a registered user...")

- completing the field according to the form map with the user data (**figure 4B,**

#440: "Browser transmits *filled out electronic form document*" inherently shows

completing a field according to the form map for a field in the electronic form with

the user data in the raw data file; **col 6, line 63 to col 7, line 23**: filling a form

with data from the privacy bank shows completing the field in the form with the

user data according to the form map)

Markus does not disclose:

- obtaining user entered data from the electronic form, wherein the user entered

data is at least one of absent from the user profile and different from the user

data in a corresponding field

- updating the user profile with the user entered data

Mohan discloses:

- obtaining user entered data from the electronic form, wherein the user entered

  data is at least one of absent from the user profile and different from the user

  data in a corresponding field ([0094]: user enters data not found in the user's

  profile)

- updating the user profile with the user entered data ([0095], [0096], [0102]:

  storing the form submitted with user-entered information to the IIM at server

  where the user-entered data can be data not found in the user's profile implies

  that data in the user profile at IIM is updated with the user-entered data)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Mohan into Markus for automatically updating the user

profile with user-entered data which is not found in the user profile. Users, thus, do not

have to remember to update the user profile every time they enter a new data not in the

user profile before.

Response to Arguments

6.   Applicant's arguments filed 10/21/05 have been fully considered but they are not

persuasive.

Applicants argue that Mohan does not disclose "updating the user profile with the user

entered data" since only the transaction database, not the user profile, is updated with

the user entered data, and the transaction database and the user profile are not "one-in-

the-same or interchangeable, as the Examiner has implied" (Remarks, page 5).

Examiner agrees that the transaction database and the user profile in Mohan are "not one-in-the-same or interchangeable." The Examiner does not imply that the transaction database and the user profile are "one-in-the-same" as Applicants said.

The Examiner just would like to point out that updating the transaction database leads to the change of the user profile (paragraph 92: the recording of the transaction database is dated as changes to the user profile) where updating the transaction database is due to entering data by a user where said entered data is not included in the user profile before (paragraph 95) and then the newly entered data is stored in the transaction database (paragraph 96). This shows that the user profile and the transaction database have some common data such that when data in the transaction database is updated with the entered data, the data in the user profile is also changed, which means updated. In other words, updating the user profile with the user entered data is performed as claimed via updating data in the transaction database.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lawton et al. (US Pat No 5,823,100, 11/3/98).

Fernando et al. (US Pat No 6,193,152, 2/27/01, filed 5/9/97).

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Primary Examiner
Art Unit 2178
12/5/05